

### **REMARKS**

Claims 1-4 and 8 have been rejected as being anticipated by U.S. Patent No. 4,288,958 to Chalmers ("Chalmers"). Without acquiescing to any of the statements recited in the Official Action concerning the Chalmers reference and expressly reserving the right to address those statements in detail in the future, Applicant respectfully traverses this rejection for the following reasons.

The subject application is a continuation of U.S. Patent Application Serial No. 10/145,471, filed May 14, 2002, now U.S. Patent No. 6,691,478, which is a continuation of U.S. Patent Application Serial No. 09/723,899, filed November 28, 2000, now U.S. Patent No. 6,761,005 ("the '005 patent"). Claim 1 of the '005 patent is reproduced below:

1. A member for supporting a plurality of joists, said member comprising:

a C-shaped rim member fabricated from metal and having a web and two leg portions;

a plurality of joist attachment tabs integrally formed in said web, said joist attachment tabs being provided at predetermined distances on said web relative to each other; and

at least one reinforcing rib corresponding to each said tab and provided in said web adjacent said corresponding tab.

This claim was deemed patentable by the PTO over Chalmers which was of

record in that application.

Independent claim 1 of the subject application includes the recitation of "at least one opening through the web"; this element is not found in claim 1 of the '005 patent. Thus, independent claim 1 of the subject application (and the claims that depend from claim 1) are **narrower in scope** than claim 1 of the '005 patent. Accordingly, because the PTO ruled that the broader claim (claim 1) of the '005 patent was patentable over the art of record and thus granted the patent, the issue of whether narrower claims, represented by claims 1-4 and 8 of the subject application, are patentable over Chalmers has already been decided by the PTO.

Under principles of collateral estoppel (or issue preclusion), in which a prior adjudication of an issue is determined to be sufficiently firm to be accorded conclusive effect, the PTO should be precluded from raising the issue of the patentability of claim 1 of this application over the Chalmers reference. Ample support for the proposition that the PTO considers the patentability of claim 1 of the '005 patent to be "firm" is found in Section 1701 of the Manual of Patent Examining Procedure which requires an Examiner to refuse to express an opinion on the patentability of any claim of a U.S. patent except under circumstances not present here. Once the PTO acted with finality on the patentability of claim 1 of the '005 patent with respect to the cited reference,

Chalmers, the PTO thereafter should be estopped to raise an issue here with respect to the patentability of a claim that is demonstrably narrower in scope than claim 1 of the '005 patent based on the same reference.

Accordingly, Applicant submits that claims 1-4 and 8 are patentable over Chalmers as a matter of law and thus respectfully traverses the rejection of those claims.

The PTO also considered Liss U.S. Patent No. 5,956,916 ("Liss") and Kostecky U.S. Patent No. 3,845,601 ("Kostecky") during the prosecution of the '005 patent. The Examiner now rejects claim 5 (which is dependent on claim 1) on Chalmers in view of Liss and claims 6 and 7 (which also are dependent on claim 1) over Chalmers in view of Kostecky. All of claims 5, 6 and 7 are dependent on claim 1 which, as established above, is narrower than claim 1 of the '005 patent. For the reasons set forth above based on the doctrine of estoppel, claims 5, 6 and 7 should be deemed patentable. Applicant, therefore, traverses their rejection.

Public policy favors the application of an estoppel against the PTO in this situation. Although not expressly stated in the Examiner's action in this application, the clear implication is that a new substantial question of patentability is raised with respect to claim 1 of the '005 patent by the Chalmers reference. A substantial new question of patentability is the basis for

the authority of the PTO to reexamine patents. 35 U.S.C. § 303. Accordingly, the Examiner, sub silentio, would be forcing the appellant to seek reexamination of the claims of the '005 patent over the very references that it now seeks to use to reject the narrower claims of the subject application. Such action contravenes the concepts of finality and reliance brought about the issuance of a U.S. patent. If the PTO believes that reexamination of the '005 patent is appropriate, then the Director should order it under 35 U.S.C. § 303. Otherwise, the Examiner should withdraw the rejections based on art cited in the prosecution of broader claims of the '005 patent.

The application of an estoppel against the PTO also is fair. There is no question that the PTO, which is the agency charged by Congress to examine and grant patents, issued unequivocal advice to the applicant on patentability by issuing the '005 patent. As alluded to above, it may be assumed that members of the public reasonably relied on that "advice" as emanating from the responsible agency. Further, the applicant would be greatly harmed if it were coerced into seeking reexamination of the '005 patent by the actions here of the Examiner, as articulated above. The presence of a gross injustice, absent an estoppel against the PTO, is plainly evident.

Furthermore, the Official Action indicates that the "functional recitation for supporting a plurality of joist[s] has not been given much patentable weight

because it does not positively claiming [sic] the joist in conjunction with the apparatus and it is in narrative form.” Applicant submits that the apparatus comprises, among other things, a “joist rim”. The use of “joist rim” in the claims is not functional. This term should be given patentable weight. Chalmers clearly does not disclose a joist rim. As indicated in Applicant’s prior response, the term “joist” does not appear anywhere in the Chalmers patent.

Applicant further submits that as was discussed above, the Chalmers patent was considered by the Examiner in charge of examining the application that matured into the ‘005 patent, but determined that it did not form the basis to prevent the allowance of any of the ‘005 patent’s claims. The Chalmers patent is directed to a “Horizontal Siding Panel System With Vertical Stringers” which is far a field from the apparatus for supporting a plurality of **joists** that is the subject matter of the pending claims. Applicant submits that Chalmers comprises non-analogous art because the skilled artisan would not look to art dealing with vertically hanging pieces of siding when addressing problems associated with supporting floor joists. The application of Chalmers as a reference should be withdrawn.

Because all of the prior art rejections rely on Chalmers as the principal reference, those rejections cannot stand when Chalmers is withdrawn.

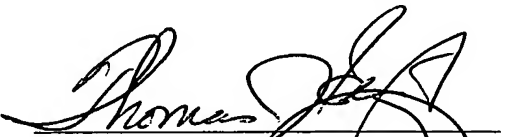
Applicant is also herewith submitting a Supplemental Information

Application No. 10/601,404  
Amendment Filed With RCE dated March 29, 2005

Disclosure Statement. Consideration of the Supplemental Information  
Disclosure Statement is respectfully requested.

Applicant has made a diligent effort to respond to the rejections presented in the Official Action and submits that all of the pending claims are in condition for allowance. Accordingly, reconsideration and withdrawal of such rejections and passage to allowance of all the pending claims are earnestly solicited. If the Examiner has any remaining concerns concerning the patentability of any of the claims, she is invited to contact the undersigned at the telephone number set forth below, so those concerns may be expeditiously addressed.

Respectfully submitted,



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